

## **REMARKS**

The present Amendment and Response is intended to be fully responsive to all points of objections and/or rejections raised by the Examiner and is believed to place the application in condition for allowance. Applicants assert that the present invention is new, non-obvious and useful. Prompt and favorable reconsideration and allowance of the claims are respectfully requested.

### **Status of the Claims**

Claims 1-13 are currently pending.

Claim 7 has been amended for correcting a typographic error.

### **Remarks to Claim Rejections**

#### ***Claim Rejections - 35 U.S.C. §112***

The May 1, 2008 Office Action rejected claims 7, 10, and 13 under 35 U.S.C. §112, first paragraph, as failing to comply with written description requirement. In particular, the Office Action alleges that the present disclosure failed to provide support for “forming an opening in said plating layer” in the above claims.

Applicants have amended claim 7 to correct a typographic error. Specifically, the word “plating” has been replaced with the word “dielectric”. Applicants assert that the amendment is fully supported by the specification of record and add no new matter. For example, support for the amendment may be found in paragraph [0062]-[0065] of the original specification. In addition, it is respectfully submitted that the amendment will not necessitate a new search because the Examiner has conducted the search based upon the correct understanding that the word “plating” shall be read as “dielectric”, as is clearly indicated by the argument presented at lines 1-3 of page 4 of the Office Action.

Claims 10 and 13 depend from claim 7. Therefore, rejections of claims 10 and 13 under 35 U.S.C. §112, first paragraph, are moot now by the amendment of claim 7.

In view of above, Applicants respectfully request that rejections of claims 7, 10, and 13 made under 35 U.S.C. §112, first paragraph, be withdrawn.

***Claim Rejections - 35 U.S.C. §102***

The May 1, 2008 Office Action rejected claims 1, 5-6 under 35 U.S.C. §102(b), as being anticipated by Larson (US 5,160,579).

Applicants respectfully disagree.

In order to anticipate a claim, a reference must teach each and every element of the claim. In particular, MPEP 2131 states that “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”, citing case law of *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicants respectfully submit that independent claims 1 and 5 of the present invention include distinctive elements that are not taught, suggested, or even implied by prior art reference Larson. Such distinctive elements include, inter alia, preparing an insulating substrate having a layer of metal foil formed on each of a front surface and a back surface of the substrate, and forming areas of the metal foils not covered by a plating layer into lines.

The Office Action alleges that Larson teaches forming areas of said metal foil not covered by said plating layer into lines, citing FIG. 1J. Applicants respectfully disagree.

Larson specifically describes, at col. 5, line 66 – col. 6, line 2, that after stripping primary plating resist 16, the copper thereunder (i.e., the copper not covered by the alleged plating layer 18) is etched away down to the substrate surface. In other words, Larson does not teach, suggest, or even imply forming the copper thereunder into lines, as specifically recited by independent claims 1 and 5, but rather describes removing the exposed copper not covered by the plating layer entirely.

Furthermore, Larson does not teach an insulating substrate having a layer of metal foil formed on each of a front surface and a back surface of the substrate. For example,

FIG. 1A through FIG.1L clearly show that copper layer 14, the supposedly alleged metal foil, is only applied to one side of substrate 10. Larson does not teach a substrate having metal foils formed on both surfaces of the substrate.

In view of above, Applicants respectfully submit that prior art reference Larson does not teach, suggest, or imply each and every element of independent claims 1 and 5, as specifically required by MPEP 2131 in order to anticipate a claim. Therefore, claims 1 and 5 are not anticipated by and are patentable over Larson.

Claim 6 depends from claim 5 and includes all the distinct elements of claim 5 as well as other distinctive features and/or elements. Therefore, claim 6 is patentable at least for the reasons as discussed above with regard to claim 5.

In view of above, it is respectfully requested that rejections of claims 1 and 5-6 made under 35 U.S.C. §102(b) be withdrawn.

### ***Claim Rejections - 35 U.S.C. §103***

The May 1, 2008 Office Action rejected claims 3 and 7 under 35 U.S.C. §103(a) as being unpatentable over Larson in view of Shipley (US 4,902,610);

rejected claims 2 and 8-9 under 35 U.S.C. §103(a) as being unpatentable over Larson in view of Tamm et al. (US 5,666,722);

rejected claim 4 under 35 U.S.C. §103(a) as being unpatentable over Larson in view of Tamm et al., and further in view of Shipley;

rejected claim 10 under 35 U.S.C. §103(a) as being unpatentable over Larson in view of Shipley, and further in view of Tamm et al.;

rejected claims 11-12 under 35 U.S.C. §103(a) as being unpatentable over Larson in view of Tamm et al., and further in view of Asai et al. (US 6,828,510); and

rejected claim 13 under 35 U.S.C. §103(a) as being unpatentable over Larson in view of Shipley, further in view of Tamm et al., and further in view of Asai et al.

Applicants respectfully disagree.

Claims 2-4 depend from claim 1 and include all the distinct elements of claim 1 as

well as other distinctive features and/or elements. Claims 7-13 depend from claim 5 and include all the distinct elements of claim 5 as well as other distinctive features and/or elements. Therefore, claims 2-4 and 7-13 are patentable at least for the reasons as discussed above with regard to claim 1 and/or claim 5.

In view of above, it is respectfully requested that rejections of claims 2-4 and 7-13 made under 35 U.S.C. §103(a) be withdrawn.

Applicants have provided the requested reference numerals in responses filed May 24, 2007, February 21, 2008, and April 10, 2008. Please refer to the above responses for the requested reference numerals.

### **Conclusion**

In view of the preceding remarks, Applicants respectfully submit that all pending claims are now in condition for allowance. Favorable reconsideration and allowance of the claims are respectfully requested.

No fees are believed to be due in connection with this paper. However, if there is any such fee due, please charge any such fee to deposit account No. 09-0458.

Respectfully submitted,

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Dated: June 16, 2008

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